

Applicant : George W. Adamson
Appl. No. : 10/589,088
Filed : 05/02/2007
Title : Security Ink

Art Unit : 1793
Examiner : Helene G. Klemanski
Attorney's Docket No.: 223309-120102

STATEMENT ESTABLISHING UNINTENTIONAL DELAY

(37 CFR § 1.137(b)(3))

The entire delay in filing the required reply from the due date for the reply until the filing of this grantable petition under 37 CFR 1.137(b), was unintentional.

Applicant's representative, Jonathan O'Brien Ph.D., is responsible for handling this case, and he provides this statement in support of Applicant's belief that the delay was unintentional. I, Jonathan O'Brien Ph.D., am the Applicant's representative referred to in this statement.

1. On Aug. 10, 2006, PCT Patent Application No. PCT/US2005/04105 was nationalized in the U.S. Patent Office by Applicant's representative and designated Patent Application No. 10/589,088. PCT Patent Application No. PCT/US2005/04105 was filed on Feb. 10, 2005, and claimed priority to U.S. provisional patent application no. 60/545,868, which was filed on Feb. 12, 2004. Patent Application No 10/589,088 is titled "Security Ink" and names George Adamson as its inventor.

2. On May 2, 2007, Applicant's representative submitted an Declaration and Power of Attorney that recited the mailing address for Applicant's representative as

Miller, Canfield, Paddock and Stone P.L.C
c/o Jonathan P. O'Brien Ph.D.
444 W. Michigan Avenue
Kalamazoo, MI 49007

The Declaration and Power of Attorney incorrectly stated that the PCT Patent Application No. PCT/US2005/04105 was filed on Feb. 12, 2004, when it was in fact filed on Feb. 10, 2005. The Declaration and Power of Attorney also named Applicant's representative and his associates as Attorneys for the Applicant.

3. On Aug. 27, 2007, the U.S. Patent Office issued a filing receipt for Patent Application No. 10/589,088. The filing receipt named George Adamson as the inventor, and recited a 371(c) date of May 2, 2007.

4. On Jan. 31, 2008, Patent Application No. 10/589,088 published as U.S. Patent Application Publication No. 20080025786.

5. In May 2008, the law firm of Miller Canfield Paddock & Stone ("Miller Canfield"), formerly Applicant's representative's employer, moved from the 444 W. Michigan Avenue, Kalamazoo, MI address and relocated to 277 South Rose Street, Kalamazoo, MI.

6. On Sept. 27, 2008, Applicant's representative terminated his employment with Miller Canfield and began employment with Honigman Miller Schwartz and Cohn LLP ("Honigman"), which was located at the prior Miller Canfield address of 444 W. Michigan Avenue, Kalamazoo, MI.

7. Between Oct. 1, 2008 and Nov. 15, 2008, Applicant's representative obtained an executed engagement letter from George Adamson Ph.D. ("Adamson"), the inventor named in Patent Application No. 10/589,088 that instructed Miller Canfield to transfer all of Adamson's legal files to Honigman. It further informed Miller Canfield that it would no longer be representing Adamson and that Honigman was Adamson's new patent counsel. The prosecution records of Adamson's legal files were moved into Honigman's office located in the former Miller Canfield office location at 444 W. Michigan Avenue, Kalamazoo, MI.

8. On March 30, 2009, Examiner Helene Klemanski issued a Non-Final Office Action that rejected several claims in Patent Application No. 10/589,088 and identified allowable subject matter in other claims.

9. The March 30, 2009 Non-Final Office Action was mailed to Miller Canfield at 444 W. Michigan Avenue, Kalamazoo, MI. The U.S. Post Office forwarded this Office Action to Miller Canfield's current address of 277 South Rose Street, Kalamazoo, MI. This Office Action had a three month shortened statutory period for reply, which was extendable to six months.

10. On April 8, 2009, Honigman received a copy of the March 30, 2009 Non-Final Office Action, which was placed into the file, but Applicant's representative was not made aware of this Office Action at that time.

11. This oversight was maintained until Oct. 6, 2009, when Examiner Helene Klemanski left a message on Applicant's representative's voice mail. The Examiner's voice mail informed Applicant's representative, who was travelling out of state at the time of the voice mail, that Patent Application No. 10/589,088 was abandoned. This voice mail message was the first communication that alerted Applicant's representative of the abandonment of Patent Application No. 10/589,088.

12. Applicant's representative urgently undertook an investigation into the abandonment of Patent Application No. 10/589,088 using the PAIR online database. Applicant's representative observed that on Oct. 14, 2009, the U.S. Patent Office issued a Notice of Abandonment. The Notice was mailed to Miller Canfield at 444 W. Michigan Avenue, Kalamazoo, MI and forwarded to Miller Canfield at 277 South Rose Street, Kalamazoo, MI. The Notice was ultimately returned to the U.S. Patent Office as undelivered.

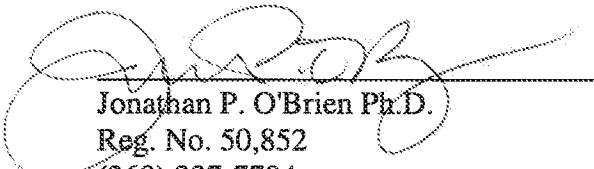
13. Applicant's representative declares that the abandonment was unintentional. The March 30, 2009 Non-Final Office Action first went to the wrong office, and was later entered into the files without my knowledge.

14. Had I known of the requirement of filing a response to the March 30, 2009 Non-Final Office Action before September 30, 2009, I would have filed the attached response that presents the claims allowed in the Non-Final Office Action and presents new claims embodying prior dependent claims that were deemed allowable by the Examiner if rewritten in independent format. Furthermore, I would have timely filed a revised Oath or Declaration and Power of Attorney or Revocation of Power of Attorney with a New Power of Attorney and Change of Correspondence Address, i.e., Form PTO/SB/81. The revised Oath or Declaration and Power of Attorney or Revocation of Power of Attorney with a New Power of Attorney and Change of Correspondence Address, i.e., Form PTO/SB/81, are also presented with this Petition.

These facts above, in this statement, supporting this Petition, are supplied by myself, Jonathan P. O'Brien Ph.D., Applicant's legal counsel, with the firm Honigman Miller Schwartz and Cohn. This Statement supports the Petition's assertion that the entire delay in filing the required reply from the due date for the reply until the filing of this grantable petition pursuant to paragraph 1.137(b) was unintentional.

I, Jonathan P. O'Brien Ph.D., further declare that all statements made herein are true to the best of my knowledge, or if made upon information and belief, are believed to be true. This Statement and Declaration is made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 USC § 1001, and may jeopardize the validity of the subject patent application or any patent issuing thereon.

Date: 17 November 2009



Jonathan P. O'Brien Ph.D.

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